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10/596,266

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Hans Peter Weitzel

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EXAMINER

KOLLIAS, ALEXANDER C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,266	Applicant(s) WEITZEL ET AL.	
	Examiner ALEXANDER C. KOLLIAS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 9/9/2009.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 9/9/2009. In particular, newly added claim 49 recites the subject matter of canceled claim 34 has been amended to recite that the composition comprises "at least one biocidal active additives selected from the group consisting of bactericide actives(s), fungicide active(s) and algicide active(s). Additionally, newly added claims recite subject matter not previously presented drawn to a specific redispersible polymer powder is a vinylacetate, vinyl versatate, and ethylene copolymer. Given that these limitations necessitate a new grounds of rejection, the following action is properly made final.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 48 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Claim 48 recites that the biocide is incorporated into the water re-dispersible polymer powder by spray drying". While the Specification, specifically the Abstract, discloses that biocides are added to the re-dispersible polymer powder, there is not explicit support in the Specification that the biocides are "incorporated into" the water re-dispersible polymer as recited in the present claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 50 and 51 recites the limitation "the solid biocide" in Line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 49 and 34-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Weitzel et al (2003/0018121).

Regarding claims 49 and 34-42, Weitzel et al discloses a composition comprising water re-dispersible polymer powder and biocides such as fungicides (Abstract, Page 1 [0009], Page 2 [0016], [0018], Page 3[0023]). The reference discloses that the polymer is mixed in an aqueous

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dispersion and spray dried. In order to prepare the composition the powder is mixed in the form of a dispersion or powder (Page 3 [0023] Page 4 [0038]). Given that the reference discloses that additives such as biocides are mixed with the polymer powder in dry form, it is clear that the biocide is present in the water re-dispersible polymer powder composition, meeting the limitations recited in the claims 49. The amount of biocide added in the amount from 0.001 to 0.2 %, within the amount of 0.001 to 0.5 % presently recited in claim 33 (Page 3 [0028]). The reference discloses that the composition comprising the re-dispersible polymer and biocide comprises fillers such as calcium carbonate, silicates, talc, clays, quartz etc, thus it is clear that the reference meets the limitations drawn to a curable mineral construction product recited in the present claims (Page 3 [0030]). The reference discloses that the composition comprises a hydraulically setting mineral binder such as lime and gypsum recited in claim 36 (Page 4, [0032]). Although the reference discloses that the composition may comprise inorganic binder such as cement, cement is not required thus meeting the limitations recited in claim 37 drawn to a curable construction product which is cement free. Regarding the biocides the reference discloses that the composition comprises biocides such as isothiazolinones such as dicloro-N-octylisothiazolinone and benzimidazole derivatives, meeting the limitations recited in claims 38-40 (Page 3 [0028]). The reference discloses polymers such as homopolymer or copolymers comprising one or more monomers of vinyl esters, vinyl halides, methacrylate, 1,3-diene, vinyl-aromatic, olefin, and optionally further monomers (Page 1 [0009] and Page 2 [0015]). Additionally, the reference discloses copolymers such as vinyl acetate, ethylene, and a vinyl ester of alpha-branched monocarboxylic acid having 9 to 11 carbon atoms, or copolymers of styrene and one or more monomers such as methyl acrylate, ethyl acrylate, propyl acrylate, n-butyl

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acrylate or 2-ethylhexyl acrylate (Pages 1-2 [0016]). Given that the reference discloses that the polymer has a glass transition temperature from -10 to 25 degree C, it is clear that the polymer is film forming (Page 2 [0015]).

Regarding the product by process limitations recited in claim 35, the reference discloses that the re-dispersible polymer powder is prepared by spray drying an aqueous dispersion comprising the polymer (Page 3, [0023]). As discussed above the reference discloses that the polymer powder in dry form is mixed with additives such as biocides (Page 4 [0038]). Therefore, the reference meets the limitations of spray drying an aqueous polymer dispersion to form a water re-dispersible polymer powder and the biocide is admixed in solid form with the water re-dispersible polymer powder recited in claim 35.

Although Weitzel does not disclose that the water re-dispersible polymer powder compositions is prepared by spray drying an aqueous polymer dispersion together with the biocide recited in claim 34, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

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Therefore, absent evidence of criticality regarding the presently claimed (process) and given that Weitzel meets the requirements of the claimed composition, (reference name) clearly meet the requirements of present claims.

Regarding claim 47, Weitzel et al teaches all the claim limitations as set forth above. Additionally, the reference discloses a process wherein the additives, including binders such as carbonates, lime gypsum and biocides are mixed with the re-dispersible polymer powder in dry form (Page 4 [0032] and [0038]). The dry mix is produced and water needed for processing is added prior processing (Page 4 [0038]). The amount of biocide added in the amount from 0.001 to 0.2 %, within the amount of 0.001 to 0.5 % presently recited in claim 33 (Page 3 [0028]). Given that the reference discloses that additives such as biocides are mixed with the polymer powder in dry form, it is clear that that the biocide in solid form is present in the water re-dispersible polymer powder composition, meeting the limitations recited in the claims 33.

In light of the above, it is clear that Weitzel et al anticipates the presently recited claims.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (2003/0018121).

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The discussion with respect to Weitzel et al as set forth in Paragraph 10 above is incorporated here by reference.

Regarding claim 50, Weitzel teaches all the claim limitations as set forth above. Additionally, Weitzel discloses copolymers comprising a mixture of vinyl acetate, ethylene and a vinyl ester of α -branched monocarboxylic acid having from 9 to 11 carbon atoms. Although the reference does not explicitly disclose vinyl versatate, it is noted that vinyl versatate is vinyl ester tert-decanoic acid, and thus the above disclosure vinyl esters of α -branched monocarboxylic with 9 to 10 carbon atoms, encompasses vinyl versatate. Additionally, the reference discloses biocides such as N-octylisothazolione (Page 3 [0028]).

While the reference fails to exemplify the presently claimed composition nor can the claimed composition be "clearly envisaged" from the reference as required to meet the standard of anticipation (cf. MPEP 2 13 1-03), nevertheless, in light of the overlap between the claimed composition and the composition disclosed by the reference, absent a showing of criticality for the presently claimed composition, it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use the composition which is both disclosed by the reference and encompassed within the scope of the present claims and thereby arrive at the claimed invention.

13. Claims 34, 44, 47-48, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (2003/0018121) in view of Botts et al (US 7,070,795).

The discussion with respect to Weitzel et al as set forth in Paragraph 10 above is incorporated here by reference.

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Regarding claim 34, Weitzel teaches all the claim limitations as set forth above. The reference teaches all the claim limitations as set forth above. However, Weitzel et al does not disclose a process wherein water re-dispersible polymer powder composition is prepared by spray drying an aqueous polymer dispersion together with a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray drying so that the active ingredient is distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a composition comprising water re-dispersible polymers and biocidal compounds and processes to spray drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spray drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claim 44, Weitzel teaches all the claim limitations as set forth above. The reference teaches all the claim limitations as set forth above. However, Weitzel et al does not

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disclose a process wherein water re-dispersible polymer powder composition is prepared by spray drying an aqueous polymer dispersion together with a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray drying so that the active ingredient is distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a composition comprising water re-dispersible polymers and biocidal compounds and processes to spraying drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claim 47, Weitzel teaches all the claim limitations as set forth above. Additionally, the reference discloses biocides such as isothiazolinones such as dicloro-N-octylisothiazolinone and benzimidazole derivatives (Page 3 [0028]).

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The reference teaches all the claim limitations as set forth above. However, Weitzel et al does not disclose a process wherein the biocides are incorporated into the water re-dispersible polymer powder by spray drying an aqueous polymer dispersion and a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray drying so that the active ingredient is distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a composition comprising water re-dispersible polymers and biocidal compounds and processes to spraying drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claim 51, the combined disclosures of Weitzel and Botts teach all the claim limitations as set forth above. Additionally, Weitzel discloses copolymers comprising a mixture of vinyl acetate, ethylene and a vinyl ester of α -branched monocarboxylic acid having from 9 to 11 carbon atoms. Although the reference does not explicitly disclose vinyl versatate, it is noted

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that vinyl versatate is vinyl ester tert-decanoic acid, and thus the above disclosure vinyl esters of α -branched monocarboxylic with 9 to 10 carbon atoms, encompasses vinyl versatate.

Additionally, the reference discloses biocides such as N-octylisothazolione (Page 3 [0028]).

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 49, 34-35 and 37-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692 recite a water re-dispersible polymer powder composition comprising a fungicide, re-dispersible polymer comprising vinyl ester monomers or copolymers comprising vinyl acetate, ethylene and vinyl

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esters of alpha-branched monocarboxylic acids having from 9 to 11 carbon atoms. Additionally, the claims recite a biocide such as isothiazolinones which are added in the amount from 0.001 to 2 % by weight. While 6,740,692 does not claim the particular isothiazolinones, note that Col. 5, Lines 63-67 and Col. 6 Lines 1-10 which states that the composition comprises isothiazolinones such as N-octylisothiazolinone, dichloro-N-octylisothiazolinone, etc and benzimidazole. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

16. Claims 33-35 and 37-46 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,740,692. Specifically, see the discussion as set forth in Paragraph 15 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

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accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see the discussion as set forth in Paragraph 9 above.

17. Claims 33-35 and 37-46 are directed to an invention not patentably distinct from claims 1-3, 5, 11-13, 15, and 17 of commonly assigned patent. Specifically, the discussion set forth in Paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,740,692, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

18. Applicant's arguments filed 9/9/2009 have been fully considered but they are not persuasive.

19. Applicant argues the rejection of claim 48 under 35 U.S.C 112 first paragraph and points to Page 2 Lines 25, and Page 8 Line 38 to Page 9 Line 13 as supporting the phrase “incorporated into”. However, Page 2 Line 25 of the present Specification broadly discloses that the composition contains a biocide while Pages 8-9 disclose how the polymer powder composition is made. The parts of the disclosure pointed to by the applicant while disclose a composition containing a biocide and method of making such a composition simply do not provide support of the phrase “incorporated into”. That is to say that the disclosure does not disclose that the biocide is incorporated into the polymer powder. Given that the Specification does not disclose that the biocide is incorporated into the polymer powder, the previously set forth rejection of claim 48 as failing to comply with 35 U.S.C 112 first paragraph is maintained.

20. Applicant argues that as amended claim 49 requires a biocide which is an “active” compound and thus is different from the complexed biocidal compounds disclosed by Weitzel. Further, Applicant argues that the term “active” is a term of art which means the bactericide, fungicide or algicide itself, i.e. neat with no further additives. As evidence of their position Applicants have filed a Declaration under 37 C.F.R. 1.132 on 9/9/2009. However, it is significant to note the following regarding the term “active”:

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The present disclosure, as originally filed, on Page 2 Lines 32-34 discloses that the composition comprises biocidal compounds, i.e. biocides, or biological active additives are bactericides, fungicides and algicides. Other than this disclosure in present Specification, there is no specific disclosure that Applicant's definition of a biologically active compound is a pure or unmodified compound.

Further it is noted that the Declaration on Page 2 (under bullet-point 6) simply states that the term "active" as used in the art refers to the active ingredient itself" and thus the complex disclosed in Weitzel is not an "active" given that the active compound in the reference is a fungicide complexed with cyclodextrin. However Applicants have not provided, other than argument, any evidence that in fact "active" in the art pertains to pure or uncomplexed biocidal compounds, and does not encompass complexed biocidal compounds.

In the Declaration the Applicant argues that the claims require "at least one biological additive consisting of.." in an attempt to limit the active compound to pure uncomplexed compounds. However, this appears to be a misinterpretation of the phrase "at least one biocidal additive selected from the groups consisting of.." recited in claims 49. It is clear from the claim construction/language that "consisting of" is a part of a Markush group and does not limit the biocide to that within the scope of an uncomplexed or pure biocidal compound.

Finally, it is noted that nothing within the scope of the present claims (c.f. the use of the phrase comprising) or a definition in the present Specification as originally filed, either limits the biocidal compound to a pure compound or excludes biocides complexed with cyclodextrin as taught by Weitzel.

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21. Regarding the unexpected results in the Declaration, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

22. Applicant argues that the rejection of the claims over Botts is improper given that the reference is non-analogous art i.e. drawn to controlled release of agricultural chemicals. However, it is noted that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Botts discloses spraying drying as a method for entrapping active ingredients in a polymer matrix. Specifically, Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time.

Further, Applicants are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one

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which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Botts is, therefore, a reasonably pertinent reference, because it teaches spray drying as a method for entrapping active ingredients in a polymer matrix in order to obtain sustained release, which is a function especially pertinent to the invention at hand.

Applicant argues that there is no motivation to combine Botts with Weitzel et al given that Weitzel discloses is drawn to a soiling of mineral coating while Botts provides encapsulated agricultural actives compounds which release the active ingredient over a long period of time. However, it is noted that not only are both references are drawn to compositions comprising active ingredients but also that Botts discloses motivation for encapsulated active ingredients in polymeric matrices as way to prolong release of active compounds. Thus given that Weitzel et al discloses a composition comprising water re-dispersible polymers and biocidal compounds and processes of spraying drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

23. Applicant argues that no rejection of claims 33-35 and 37-46 was set forth in the double patenting rejection. However, attention is drawn to Paragraph 14 of the previous Office Action that sets forth the double patenting rejection. Further while Applicant argues that the double

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patenting rejection of the present claims over the claims in US 6,740,692 is improper given that US '692 requires complexed biocidal compounds, however, as discussed above, there is nothing in the present claims to prohibit or exclude the biocidal compound from being complexed.

Further, Applicant argues that the showing of unexpected results have not been properly considered. Specifically, Applicant argues that if side by side comparison were to be made, the microbial growth would have been much higher as evidenced by the data present in the Declaration. However, it is noted that the US '692 already recognizes the criticality of the claimed amounts of biocide of 0.01 to 0.5 wt % given that the reference recited a composition comprising 0.001 to 2 wt % biocide. therefore the data in the Declaration is not found to be persuasive.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)-270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./

Examiner, Art Unit 1796

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796